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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/010,408      | 12/07/2001  | John J. Castellot JR. | MBI-004CN           | 6101             |

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| EXAMINER |
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MARTINELL, JAMES

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| ART UNIT | PAPER NUMBER |
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1631

DATE MAILED: 05/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/010,408

Applicant(s)

CASTELLOT, JOHN J.

Examiner

James Martinell

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-63 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 48-50, 58, and 60, drawn to polynucleotides, vectors, host cells, and methods for producing proteins, and methods for detecting nucleic acids, classified in class 536, subclass 23.5 and class 435, subclasses 320.1, 325, 252.3, 69.1, and 6.
- II. Claims 22 and 23 drawn to non-human transgenic animals, classified in class 800, subclass 13.
- III. Claims 24-34 and 38, drawn to proteins and pharmaceutical compositions, classified in class 530, subclass 350 and class 514, subclass 12.
- IV. Claims 35-37 and 39, drawn to antibodies and pharmaceutical compositions, classified in class 530, subclass 387.1 and class 424, subclass 130.1.
- V. Claims 40-42, 45, 53, 54, 56, 57, 62, and 63, drawn to methods for modulating cell-associated activity using polypeptides, classified in class 514, subclass 12.
- VI. Claims 40, 43, 45, 47, 53, and 55-57, drawn to methods for modulating cell-associated activity using polynucleotides, classified in class 514, subclass 44.
- VII. Claims 40, 44, and 45, drawn to methods for modulating cell-associated activity using antibodies, classified in class 514, subclass 2.
- VIII. Claim 46, drawn to methods for treating subjects using a modulator of undisclosed nature, classified in class unknown, subclass unknown.
- IX. Claims 48, 51, and 52, drawn to methods for detection of proteins, classified in class 435, subclass 7.1.
- X. Claim 61 drawn to methods of isolating a protein, classified in class 530, subclass 344.

Claim 59 is not grouped because it is an improper multiple dependent claim.

The inventions are distinct, each from the other because of the following reasons.

The inventions are distinct, each from the other for the following reasons. The polynucleotides, vectors, and host cells of Group I are, materially different from, and are therefore independent and

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distinct from, the transgenic animals of Group II, the polypeptides of Group III and the antibodies of Group IV. The compositions and methods of Group I are not needed to practice the methods of any one of Groups V or VII-X. The compositions of Group I have uses other than the methods of Group VI. For example, the nucleic acids of Group I may be used for affinity chromatography. The transgenic animals of Group II are materially different from, and are therefore independent and distinct from, the proteins of Group III and the antibodies of Group IV. The transgenic animals of Group II are not needed to practice any of the methods of Groups V-X. The proteins of Group III are materially different from, and are therefore independent and distinct from the antibodies of Group IV. The proteins and compositions of Group III can be used for methods other than those of Groups V-X (*e.g.*, in affinity chromatography). The antibodies of Group IV have uses other than the uses of Groups V-X (*e.g.*, in affinity chromatography). Each of the methods of Groups V-X can be practiced independently of each of one another.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

To search any two groups as outlined above would create an undue burden for the U.S. PTO because the searches of the non-patent literature are not only non-overlapping to any appreciable extent, but are also divergent in nature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1633 at (703) 308-4242. The faxing of such papers must conform to the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and

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can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to [james.martinell@uspto.gov](mailto:james.martinell@uspto.gov). Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
**James Martinell, Ph.D.**  
**Primary Examiner**  
**Art Unit 1631**